



Reply Brief
U.S. Application Serial No. 09/747,666
Attorney Docket No. 031792-0311500

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

Confirmation No.: 9832

Eugene J. ROLLINS et al.

Group Art Unit: 3621

Serial No.: 09/747,666

Examiner: C. Hewitt, II

Filed: December 22, 2000

Title: TRACKING TRANSACTIONS BY USING ADDRESSES IN A COMMUNICATIONS NETWORK

REPLY BRIEF

Mail Stop Appeal Brief-Patents
The Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. INTRODUCTION

This Reply Brief is being filed in triplicate within two months of an Examiner's Answer dated September 7, 2004 (the "Answer"). This Brief responds to the various factual inaccuracies in the Answer and certain points of the Examiner's argument that have been clarified by the Answer.

A. The Status of the Claims

Claims 1-10, 18-27, and 35-37 are pending in the application. Claims 11-17 and 28-34 have been cancelled. Claims 1, 3-10, 18, 20-27, and 35-37 stand rejected under 35 U.S.C. §102(e) as allegedly being unpatentable over U.S. Patent No. 6,029,141 to Bezos et al. ("Bezos"). Claims 2 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bezos in view of U.S. Patent No. 6,532,492 to Presler-Marshall ("Presler-Marshall").

II. RESPONSE TO EXAMINER'S ARGUMENTS

A. The Examiner's Statements Concerning an Agreement Between the Examiner and Appellants' Representatives Regarding the Use of Allegedly Conditional Language is Incorrect

The Examiner and Appellants' Representatives Did Not Reach an Agreement Regarding Allegedly Conditional Language

The Examiner erroneously alleges that an agreement was reached between the Examiner and the Appellants' representatives on the use of the language "when" in order for the claims to read in "non-conditionally." See Answer, p. 6. No such agreement was ever reached. In fact, during an Examiner's Interview on October 21, 2003, the Examiner indicated that certain portions of the claim included conditional language that allowed certain claim elements to be ignored in view of the prior art. Appellants' representatives explained to the Examiner that this was improper and reminded the Examiner of his requirement to consider each and every element in the claims. Despite these explanations, the Examiner maintained his position.

Appellants subsequently filed a Response to an Office Action, dated November 3, 2003 ("Response"), further explaining to the Examiner that this position was incorrect, and also requesting that the Examiner provide a basis in law for his position should he elect to maintain the rejection. Thus, there was clearly no agreement and the Examiner's recollection of events is factually inaccurate.

The Examiner's Response to Arguments Regarding Conditional Language are Factually Incorrect

The Examiner also erroneously asserts that "the Examiner did not regard claim 1 as including optional or non-conditional language once the term "if" was replaced with "when." See Answer, p. 6. However, claims 1 and 18 are original claims and have not ever been amended. In fact, the listing of claims provided in the appendix of Appellants' Brief on Appeal clearly indicates that claims 1 and 18 as originally filed included the term "when." Again, the Examiner's allegations are factually inaccurate.

The Examiner ultimately issued a Final Office Action, dated December 17, 2003 (“Final Office Action”) applying the Bezos reference to every element of claims 1 and 18 as originally filed, including those elements that the Examiner previously ignored.

In a Response to the Final Office Action dated March 17, 2004 (“Response to Final”), Appellants noted that the Examiner had apparently agreed that it was improper to ignore certain claim elements because the Examiner, in the Final Office Action, had addressed all the features of claims 1 and 18, including those that he had previously ignored. The Examiner’s response, in the form of an Advisory Action mailed March 31, 2004, was that his position had not changed.

Despite the Examiner’s attempts now to summarily dismiss this issue on appeal, it still remains, because the record does not clearly indicate what the Examiner’s position on the alleged “conditional language” is.

B. The Examiner has Improperly Interpreted the Bezos Reference and has Inconsistently Applied its Alleged Disclosure to the Claims

Bezos Does Not Disclose Each and Every Element of the Claims

The Examiner apparently argues that a process of connecting computers via hyperlinking and hypertext, as allegedly taught by Bezos, reads on every element of various claims, including claim 1. As described in Appellants’ Brief on Appeal, Bezos fails to disclose at least the features of “determining whether a combined address satisfies a particular condition” and “substituting a portion of the combined address when the combined address does not satisfy the particular condition,” as recited in independent claim 1.

In the Final Office Action, the Examiner apparently relies on various Figures in Bezos that present renderings of web pages to disclose these missing elements of claim 1. The Examiner was unable to identify any specific portions of the text of Bezos that disclose these missing elements, because they are not disclosed by Bezos. In the Answer, the Examiner has identified various passages of Bezos where these missing

elements are allegedly disclosed. However, the Examiner has misconstrued the claims and expanded the scope of Bezos well beyond the disclosure it provides.

Specifically, the Examiner appears to be equating a condition associated with a combined address as set forth, for example in claim 1, with a condition associated with a web page or more particularly, the content of a web page. As best can be understood, the Examiner is alleging that a user formulates a condition, where the condition is the ability to purchase a book. The user can then navigate to another webpage if the so-called “condition” of enabling him to purchase the book is not met. Following the Examiner’s logic, the user evaluates the content or information presented to him on the web page.

However, this is not the invention set forth in claim 1, which, following the Examiner’s reasoning, would require the user to determine whether the combined address satisfies a particular condition. At best, the Examiner’s interpretation of Bezos discloses the user determining whether **content** at a combined address satisfies a particular condition. This is clearly not the same as determining whether **a combined address** itself satisfies a particular condition. Hence, Bezos does not disclose at least this element of the claimed invention.

The Examiner further alleges that, according to Bezos, the user clicks on a hyperlink which takes the user from the intermediary website to the merchant website thus substituting a portion of the intermediary URL with the merchant’s thus creating a modified combined address. See Answer, pp. 7-8. The Examiner has again mischaracterized Bezos. When the user wishes to make a purchase, the user selects a referral link to be taken to a new web page. This is not a modification of an address, but rather an entirely new address. The address referenced by the referral link is not one modified to satisfy a particular condition. In fact, the address associated with the referral link is a fixed address that has already been created at the associate website. See Bezos, column 11, line 63 – column 12, line 13.

Because Bezos does not disclose evaluating an address to determine if a particular condition is met, the Examiner's rejection of claim 1 must be reversed. Independent claims 18 and 35-37 recite similar elements. Thus, these claims and claims 3-9 and 20-26 which depend therefrom are patentable over Bezos for at least these reasons and the reasons provided in Appellants' Brief on Appeal. Accordingly, the Examiner's rejections of these claims as anticipated by Bezos must be reversed.

Regarding claims 10 and 27, the Examiner argues that Bezos discloses "receiving a modified combined address, wherein the modified combined address is based on a combined address that does not satisfy a particular condition." This argument is based on the same flawed reasoning applied to claim 1 – that the condition is the ability to purchase a book. As described above, the claim language refers to a particular condition associated with the combined address, not a user-defined condition based on the content of a web page. Furthermore, as described above, a modified combined address is not based on a combined address that does not satisfy a particular condition. In contrast, according to Bezos, the user may select a fixed, predetermined URL to navigate to an entirely new web page. Thus, the rejection of claims 10 and 27 must also be reversed for at least these reasons.

C. The Examiner's Use of Presler-Marshall in Combination with Bezos to Reject the Claims is Improper

The Examiner's Characterization and Application of Presler-Marshall is Incorrect

The Examiner has maintained a rejection of claims 2 and 19 under 35 U.S.C. § 103(a) alleging that these claims are unpatentable over Bezos in view of Presler-Marshall. Appellants have repeatedly asserted that the Examiner's reliance on Presler-Marshall to teach "determining whether a first size or the combined address does or does not exceed a specified size" is improper. In response, the Examiner asserts that Appellant "grossly misconstrues the teaching of Presler-Marshall" in the Examiner's answer. However, it is the Examiner who has apparently misconstrued the teachings of Presler-Marshall.

As previously presented in Appellants' Brief on Appeal, Presler-Marshall appears to generally describe a cache admittance protocol having both an object cache for including information to be cached and an address cache. A received object (information unit) may have an address associated with it. According to Presler-Marshall, a determination is made as to whether the size of the candidate object exceeds a predetermined criteria in order to determine whether the candidate object should be admitted into the object cache. See Presler-Marshall, Fig. 3; column 8, lines 17-33. Thus, at best, Presler Marshall discloses determining whether an object meets a certain criteria, in this case, size. Presler-Marshall is silent with regard to determining whether an address meets certain criteria.

The Examiner alleges that Presler-Marshall "explicitly recites candidate objects such as URLs" and refers to various passages in Presler-Marshall to support this allegation. However, a close inspection of the cited passages as well as Presler-Marshall as a whole proves that this is entirely incorrect. The Examiner continues to misconstrue the teachings of this reference. For example, Presler-Marshall at column 3, lines 30+, discloses:

In a first aspect, the present invention applies a cache admittance protocol based on an address associated with a unit of information (candidate object) which has been requested, such as a URL associated with a particular file.

In this passage, "a URL associated with a particular file" is given as an example of "an address associated with a unit of information." However, the Examiner has erroneously construed this passage as a URL being an example of a candidate object. This is simply not the case. Presler-Marshall does not teach that a URL is a candidate object; rather, Presler-Marshall teaches that a URL may be associated with a candidate object.

None of the other passages of Presler-Marshall cited by the Examiner support the Examiner's interpretation of the passage set forth above. In fact, the reference as a whole supports the interpretation set forth by Appellants that at best, Presler-Marshall discloses determining whether the size of the candidate object exceeds a

predetermined criteria and not whether the size of the address exceeds a predetermined criteria.

In fact, Presler-Marshall at column 8, lines 26-30, which was also cited by the Examiner, explicitly recites that “the associated address for the candidate object is a URL address. The cache admittance logic 34 then determines if the size of the candidate object exceeds a predetermined criterion (block 102).” Clearly, according to Presler-Marshall, the candidate object and not the address is measured against the predetermined size.

Claims 2 and 19 recite that an address is evaluated to determine whether the size of a combined address exceeds a specified size. Since Presler-Marshall does not teach or suggest this feature, the rejection of claims 2 and 19 must be reversed.

There is No Suggestion or Motivation to Combine Presler-Marshall with Bezos

Even if Bezos and Presler-Marshall taught all of the claim elements as alleged by the Examiner, which they clearly do not, there is no motivation to combine the two references. To establish a *prima facie* case of obviousness, the Final Rejection must provide an objective motivation to combine the references. Here, it does not. The Court of Appeals for the Federal Circuit has stated:

[The PTO] can satisfy [the obviousness] burden only by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Tech Air Inc. v. Denso Mfg. Michigan, Inc., 53 U.S.P.Q.2d 1294, 1298 (Fed. Cir. 1999)(citing *In re Fine*, 837 F.2d 1071, 1074(Fed. Cir. 1988)).

“Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *Crown Operations Int’l, Ltd. v. Solutia Inc.*, 289 F.3d 1367,1376 (Fed. Cir. 2002) (quoting *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998)). The Final

Rejection fails to establish a legally sufficient basis for combining the references, let alone any objective motivation to modify Bezos.

Bezos appears to describe a method for performing electronic ordering. Presler-Marshall appears to describe a cache admittance protocol. Bezos provides no hint or suggestion of a need to modify an address that does not meet a certain condition. The Examiner's alleged motivation is that combining the references would have been obvious "in order to improve system performance by only caching hashes of web addresses that are smaller in length than the actual address." However, the teachings of Bezos have nothing to do with the caching, much less, the caching of web addresses and as set forth above, neither does Presler-Marshall. Accordingly, there is no plausible explanation for how or why one of ordinary skill in the art would be motivated to combine these references in the manner set forth by the Examiner because, the references themselves simply do not teach what the Examiner purports them to teach. Without a proper suggestion to combine the two references, the rejection of claims 2 and 19 is legally improper and must be reversed.

D. Examiner's Repeated Remarks that Appellants' Claims are "Too Broad" Have No Basis in the Law

The Examiner alleges that Appellants' arguments are not persuasive because they fail to consider the breadth of Appellants' claims. See Examiner's Answer, page 10. These assertions were also made in the Examiner Interview and during recent discussions with Supervisory Examiner Trammel¹ who also implied that the claims were not patentable simply because they were "too broad." It appears that the Examiners have prejudged the claims based on their breadth, rather than whether the cited references actually anticipate them or render them obvious. The patent laws do not specify a maximum breadth of a claim. The breadth of the claims is only relevant to the extent that the Examiner is able to identify a reference or proper combination of

¹ SPE Trammell apparently reviewed Appellants' Brief on Appeal, discussed the Appeal and the Examiner's rejections with Examiner Hewitt, and concurred with them as evidenced by SPE Trammell's signature on the Examiner's Answer.

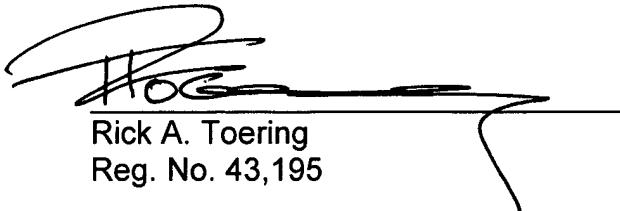
references that disclose, teach or suggest the claimed invention. That, the Examiner has failed to do in spite of the alleged breadth of the claims.

Appellants now appeals to this Honorable Board to promptly reverse these rejections and issue a decision in favor of Appellants. All of the claims are in condition for allowance.

DATE

Respectfully submitted,

PILLSBURY WINTHROP LLP



Rick A. Toering
Reg. No. 43,195

PILLSBURY WINTHROP LLP
P.O. Box 10500
McLean, Virginia 22102
Tel.: (703) 905-2000
Fax: (703) 905-2500

RAT/DAB/dcb